

ESTTA Tracking number: **ESTTA640114**

Filing date: **11/20/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	ICON NY Holdings LLC		
Entity	limited liability company	Citizenship	Delaware
Address	1450 Broadway 3rd Floor New York, NY 10018 UNITED STATES		
Attorney information	Theodore R. Remaklus Wood, Herron & Evans, L.L.P. 441 Vine Street 2700 Carew Tower Cincinnati, OH 45202 UNITED STATES tremaklus@whe-law.com Phone:5132412324		

Applicant Information

Application No	86281210	Publication date	10/21/2014
Opposition Filing Date	11/20/2014	Opposition Period Ends	11/20/2014
Applicant	CANMI, S.A. de C.V. Fracc. Industrial Alce Blanco Naucalpan de Juarez, 53370 MEXICO		

Goods/Services Affected by Opposition

Class 025. First Use: 0 First Use In Commerce: 0
All goods and services in the class are opposed, namely: hosiery, namely, pantyhose, stockings, socks; underwear


Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)

Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	729513	Application Date	07/11/1961
Registration Date	04/03/1962	Foreign Priority Date	NONE
Word Mark	CANNON		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 024. First use: First Use: 1916/01/00 First Use In Commerce: 1916/01/00 Towels and Toweling, Sheets and Sheeting, Pillow Cases, Bed Spreads and Coverlets, Blankets, Table Cloths and Napkins, Drapes and Curtains, Shower Curtains, Decorative and Drapery Fabrics, Play Rugs, Bath Mats and Bath Rugs, Toilet Seat Covers, Wash Cloths, Household Utility Cloths, Pot Holders, [Diapers,] Cotton Piece Goods and Terry Cloth


U.S. Registration No.	1127537	Application Date	12/27/1977
Registration Date	12/11/1979	Foreign Priority Date	NONE
Word Mark	CANNON		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 020. First use: First Use: 1977/12/20 First Use In Commerce: 1977/12/20 PILLOWS</p> <p>Class 024. First use: First Use: 1916/01/00 First Use In Commerce: 1916/01/00 TOWELS AND TOWELING, SHEETS AND SHEETING, PILLOWCASES, BEDSPREADS AND [COVERLETS,] BLANKETS, [TABLE CLOTHS AND NAPKINS, DRAPES AND CURTAINS,] SHOWER CURTAINS, [DECORATIVE AND DRAPERY FABRICS,] TOILET SEAT COVERS, WASHCLOTHS, HOUSEHOLD UTILITY CLOTHS, POT HOLDERS, COTTON PIECE GOODS, TERRY CLOTH, MATTRESS PADS, QUILTS, COMFORTERS, DUST RUFFLES, [WALL HANGINGS, FURNITURE COVERS, BLANKET COVERS, TOILET TANK SETS, PLACE MATS,] OVEN MITS, POT GRABBERS, [TOASTER COVERS, BLENDER COVERS, DUVET COVERS,] VALANCES AND PILLOWS SHAMS, ALL MADE OF FABRIC</p> <p>Class 027. First use: First Use: 1929/00/00 First Use In Commerce: 1929/00/00 PLAY RUGS, BATH MATS, BATH RUGS AND CARPETING</p>		


U.S. Registration No.	3725008	Application Date	05/01/2009
Registration Date	12/15/2009	Foreign Priority Date	NONE
Word Mark	CANNON KIDS		

Design Mark	CANNON KIDS
Description of Mark	NONE
Goods/Services	Class 024. First use: First Use: 2009/03/01 First Use In Commerce: 2009/03/01 Bath towels; Bed blankets; Bed sheets; Bed skirts; Bed spreads; Bed throws; Hand towels Class 027. First use: First Use: 2009/01/10 First Use In Commerce: 2009/01/10 Bath mats; Rugs


U.S. Registration No.	3725009	Application Date	05/01/2009
Registration Date	12/15/2009	Foreign Priority Date	NONE
Word Mark	CANNON TEEN		
Design Mark	CANNON TEEN		
Description of Mark	NONE		
Goods/Services	Class 024. First use: First Use: 2009/03/01 First Use In Commerce: 2009/03/01 Bed blankets; Bed sheets; Bed skirts; Bed spreads; Bed throws; Pillow cases; Pillow shams		


U.S. Registration No.	3387019	Application Date	07/07/2004
Registration Date	02/19/2008	Foreign Priority Date	NONE
Word Mark	CANNON		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 021. First use: First Use: 2007/09/00 First Use In Commerce: 2007/09/00 Soap containers; soap dishes; soap dispensers; toothbrush holders;[trash cans;] and wastepaper baskets Class 024. First use: First Use: 2006/02/00 First Use In Commerce: 2006/02/00 Bath linen; bath towels; bed linen; bedsheets; dish cloths; kitchen towels

U.S. Application No.	85345402	Application Date	06/14/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CANNON BABY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 018. First use: First Use: 0 First Use In Commerce: 0 Diaper bags		

U.S. Application No.	85345414	Application Date	06/14/2011
Registration Date	NONE	Foreign Priority	NONE

		Date	
Word Mark	CANNON BABY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 020. First use: First Use: 0 First Use In Commerce: 0 Baby bouncers; baby head support cushions; bassinets; cribs; curtain rings; drapery hardware, namely, traverse rods, poles, curtain hooks, curtain rods and finials; fitted covers for high chairs; high chairs; maternity pillows; mats for infant playpens; mattresses; nursing pillows; pillows; playpens		


U.S. Application No.	85345432	Application Date	06/14/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CANNON BABY		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 021. First use: First Use: 0 First Use In Commerce: 0 Baby bath tubs; bath accessories, namely, cup holders; cotton ball dispensers; soap dishes; soap dispensers; toothbrushholders; waste baskets; laundry hampersfor domestic or household use		

U.S. Application No.	85345523	Application Date	06/14/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CANNON BABY		

Design Mark	CANNON BABY
Description of Mark	NONE
Goods/Services	Class 024. First use: First Use: 0 First Use In Commerce: 0 Baby bedding, namely, fitted bed sheets, flat bed sheets, crib sheets, bassinet-sheets, cradle sheets, pillow cases, throws, pillow covers, crib bumper pads, blankets, quilts, comforters, duvets and duvet covers, crib bumpers, diaper changing pad covers made from fabric, mattress pads, crib canopies, crib skirts, cribdust ruffles, receiving blankets; hooded towels; fabric diaper stackers; burp cloths; bath towels; wash cloths; fabric window coverings and treatments, namely,curtains, draperies, sheers, swags and valances

U.S. Application No.	85345890	Application Date	06/14/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CANNON BABY		
Design Mark	CANNON BABY		
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 0 First Use In Commerce: 0 Headwear and footwear for infants, babies, toddlers and children; infantwear; infant and toddler one-piece clothing; infant wearable blankets; cloth bibs; cloth diapers		

U.S. Application No.	85345902	Application Date	06/14/2011
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	CANNON BABY		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 027. First use: First Use: 0 First Use In Commerce: 0 Bath mats; non-slip bath tub mats; rugs

Attachments	73153390#TMSN.png(bytes) 77727009#TMSN.png(bytes) 77727025#TMSN.png(bytes) 78979510#TMSN.png(bytes) 85345402#TMSN.png(bytes) 85345414#TMSN.png(bytes) 85345432#TMSN.png(bytes) 85345523#TMSN.png(bytes) 85345890#TMSN.png(bytes) 85345902#TMSN.png(bytes) Notice of opposition (active by cannon).pdf(27768 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/theodore r remaklus/
Name	Theodore R. Remaklus
Date	11/20/2014

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

_____)	
ICON NY Holdings LLC,)	Opposition No. _____
)	
Opposer,)	
)	Application No. 86/281,210
v.)	Published: October 21, 2014
)	
CANMI, S.A. de C.V.)	
)	
Applicant.)	
_____)	

NOTICE OF OPPOSITION

Opposer, ICON NY Holdings LLC, a Delaware limited liability company having a place of business at 1450 Broadway, 3rd Floor, New York, New York 10018 ("Opposer"), believes that it will be damaged by registration of the trademark ACTIVE BY CANNON of Application No. 86/281,210 for "hosiery, namely, pantyhose, stockings, socks; underwear" in International Class 25, and hereby opposes the same.

GROUND FOR OPPOSITION

As grounds for this opposition, Opposer alleges as follows:

1. Opposer is the owner of the CANNON brand, a consumer home products brand, with a particular emphasis on bath and bed linens. The CANNON brand dates back to the early 1900s, when Cannon Mfg., Co., a predecessor-in-interest to Opposer, began selling fabric towels under the CANNON mark in combination with a Cannon design and a stack of cannonballs, shown to the right. The CANNON brand quickly expanded into bedding, towel textile products, rugs and pillows, in the mid-2000s expanded into the other consumer home products. The CANNON brand is one of the most



powerful brands in home textiles. In 2009, a survey by Home Furnishings News found that the CANNON brand was the 16th most recognized brand overall in home furnishings in the United States, and the 6th most recognized textile brand. Opposer and its predecessors-in-interest have used the CANNON brand continuously since at least 1916.

2. Opposer is the owner of the following CANNON-bearing United States

Trademark Registrations and pending applications:

CANNON Registration No. 729,513 (incontestable), registered on April 3, 1962, claiming a first use date of January, 1916

Class 24 – Towels and toweling, sheets and sheeting, pillow cases, bed spreads and coverlets, blankets, table cloths and napkins, drapes and curtains, shower curtains, decorative and drapery fabrics, play rugs, bath mats and bath rugs, toilet seat covers, wash cloths, household utility cloths, pot holders, cotton piece goods and terry cloth

CANNON Registration No. 1,127,537 (incontestable), registered on December 11, 1979, claiming a first use date of December 20, 1977 in Class 20, January, 1916 in Class 24, and 199 in Class 27

Class 20 – pillows

Class 24 – Towels and toweling, sheets and sheeting, pillowcases, bedspreads, blankets, shower curtains, toilet seat covers, washcloths, household utility cloths, pot holders, cotton piece goods, terry cloth, mattress pads, quilts, comforters, dust ruffles, oven mits, pot grabbers, valances and pillows shams, all made of fabric

Class 27 – Play rugs, bath mats, bath rugs and carpeting

CANNON KIDS Registration No. 3,725,008, registered on December 15, 2009, claiming a first use date of March 1, 2009 in Class 24 and January 10, 2009 in Class 27

Class 24 – Bath towels; bed blankets; bed sheets; bed skirts; bed spreads; bed throws; hand towels

Class 27 – Bath mats; rugs

CANNON TEEN Registration No. 3,725,009, registered on December 15, 2009, claiming a first use date of March 1, 2009

Class 24 – Bed blankets; bed sheets; bed skirts; bed spreads; bed throws; pillow cases; pillow shams

CANNON Registration No. 3,387,019 (incontestable), registered on February 19, 2008, claiming a first use date of September, 2007

Class 21 – Soap containers; soap dishes; soap dispensers; toothbrush holders; trash cans; and wastepaper baskets

Class 24 – Bath linen; bath towels; bed linen; bed sheets; dish cloths; kitchen towels

CANNON BABY Application No. 85/345,402, filed June 14, 2011 on basis of intent-to-use

Class 18 – Diaper bags

CANNON BABY Application No. 85/345,414, filed June 14, 2011 on basis of intent-to-use

Class 20 – Baby bouncers; baby head support cushions; bassinets; cribs; curtain rings; drapery hardware, namely, traverse rods, poles, curtain hooks, curtain rods and finials; fitted covers for high chairs; high chairs; maternity pillows; mats for infant playpens; mattresses; nursing pillows; pillows; playpens

CANNON BABY Application No. 85/345,432, filed June 14, 2011 on basis of intent-to-use

Class 21 – Baby bath tubs; bath accessories, namely, cup holders; cotton ball dispensers; soap dishes; soap dispensers; toothbrush holders; waste baskets; laundry hampers for domestic or household use

CANNON BABY Application No. 85/345,523, filed June 14, 2011 on basis of intent-to-use

Class 24 – Baby bedding, namely, fitted bed sheets, flat bed sheets, crib sheets, bassinet sheets, cradle sheets, pillow cases, throws, pillow covers, crib bumper pads, blankets, quilts, comforters, duvets and duvet covers, crib bumpers, diaper changing pad covers made from fabric, mattress pads, crib canopies, crib skirts, crib dust ruffles, receiving blankets; hooded towels; fabric diaper stackers; burp cloths; bath towels; wash cloths; fabric window coverings and treatments, namely, curtains, draperies, sheers, swags and valances

CANNON BABY Application No. 85/345,890, filed June 14, 2011 on basis of intent-to-use

Class 25 – Headwear and footwear for infants, babies, toddlers and children; infantwear; infant and toddler one-piece clothing; infant wearable blankets; cloth bibs; cloth diapers

CANNON BABY Application No. 85/345,902, filed June 14, 2011 on basis of intent-to-use

Class 27 – Bath mats; non-slip bath tub mats; rugs

The above marks are referred to collectively herein as the "CANNON Marks".

3. Opposer and/or its predecessors-in-interest and/or licensees have used the CANNON Marks continuously on or in connection with the above goods since the date of first use recited in the registrations. Those marks have also been the subject of substantial marketing and advertising in the United States in connection with the goods of Opposer, and Opposer, its predecessors-in-interest and licensees have spent millions of dollars in promoting the goods under the CANNON Marks. As a result of the long and continuous use and promotion of the CANNON Marks, those marks have come to be associated exclusively with Opposer and/or its predecessors-in-interest, as identifying goods emanating from Opposer, and are famous.

4. On information and belief, Applicant is CANMI, S.A. de C.V., a Mexican sociedad anomina (sa de cv), with an address of Fracc. Industrial Alce Blanco Negra Modelo 38 Naucalpan de Juarez, Mexico 53370 (hereinafter ("CANMI")).

5. On information and belief, CANMI filed intent-to-use Application No. 86/281,210 (hereinafter "the '210 Application") on October 21, 2014 for the trademark ACTIVE BY CANNON for "hosiery, namely, pantyhose, stockings, socks; underwear" in International Class 25, which was published for opposition on October 21, 2014.

6. CANMI's filing date is subsequent to Opposer's first use of the CANNON trademark and after the filing date of Opposer's pending applications.

7. The trademark ACTIVE BY CANNON incorporates the entirety of Opposer's CANNON mark, and the dominant portion of the ACTIVE BY CANNON mark is the word "Canon", which is identical to the CANNON Marks of Opposer.

8. Moreover, the ACTIVE BY CANNON mark uses the "CANNON" term as the source. That is, the products are "By Cannon". However, the source of "CANNON" branded products in the United States for nearly 100 years has been Opposer and its predecessors.

9. Likewise, the goods in the '210 Application with which the ACTIVE BY CANNON are allegedly intended to be used are related to those sold by Opposer and its licensees under the CANNON mark in that they are textile products, and are within the reasonable zone of expansion for Opposer and its CANNON marks.

10. As a result of the similarity of the marks and goods, the use by CANMI of the ACTIVE BY CANNON mark would be likely to cause confusion among consumers of those goods.

11. The ACTIVE BY CANNON mark is likely to cause confusion or to cause mistake or to deceive consumers by creating the false impression that CANMI's goods originate with or are from the same source as Opposer's goods, or are endorsed by, sponsored by, or otherwise connected or affiliated in some way with Opposer and the CANNON Marks.

12. CANMI's ACTIVE BY CANNON mark is likely to dilute Opposer's distinctive and famous CANNON Marks in violation of Section 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

13. CANMI is not entitled to use or register the ACTIVE BY CANNON trademark for the goods recited in the '210 Application.

14. Under Section 7(b) of the Lanham Act, 15 U.S.C. § 1057(b), if a certificate of registration were to issue to CANMI it would be *prima facie* evidence of, among other things, its right to use the mark in commerce on the goods recited in the application, and such use would be

likely to cause confusion, or to cause mistake, or to deceive purchasers by reason of the similarity thereof to Opposer's CANNON Marks.

WHEREFORE, Opposer believes that it will be damaged by registration of the ACTIVE BY CANNON trademark, and prays that the '210 Application be refused and registration denied.

The fee required under 37 C.F.R. § 2.6(a)(17) is being submitted herewith. The Commissioner is authorized to charge Deposit Account No. 23-3000 for any deficiencies in the filing fee and any and all other fees associated with filing the Notice of Opposition.

Respectfully submitted,

ICON NY Holdings LLC

Date: November 20, 2014

By: /s/ Theodore R. Remaklus
Theodore R. Remaklus
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Attorneys for Opposer
ICON NY Holdings LLC

CERTIFICATE OF SERVICE

I hereby certify that a true and correct copy of the foregoing **Notice of Opposition** has been served by first class mail, postage prepaid, upon Jonathan Pierce, Porter Hedges LLP, P.O. Box 4744, Houston, Texas 77210-4744, the listed correspondence address, this 20th day of November, 2014.

/s/ Theodore R. Remaklus

Theodore R. Remaklus

Attorney for Opposer
ICON NY Holdings LLC